

Appl. No. 09/759,188
Reply to Office action of 08/17/2004

Attorney Docket No. ADC-501

REMARKS/ARGUMENTS

Claims 1 and 20 have been amended based on the agreed upon content of the interview with the Examiner of 9/22/2004. Claims 2-19, and 21-42 remain unchanged.

The above claim amendments are fully supported by the original specification as filed, and do not contain any new matter.

Independent claims 1 and 20 have been amended to emphasize that the same at least one IP asset that was developed for a first application is evaluated and developed into a second application, thereby enabling the reuse of existing IP assets.

The Examiner rejected independent claims 1 and 20 under 35 U.S.C. 103 (a) as being unpatentable over R1 (Article 6/26/200 "A view from Buenos Aires") in view of R2 (Article on SmartPatents, June 30, 1997). The R1 article discusses the issues that internet and e-commerce start-up businesses face worldwide and in particular in Latin America. The R2 article discusses a patent database software. The Examiner claims that R1 discloses steps a) and b) of claim 1. R1 discloses forming a holding company. However, R1 does not disclose forming a holding company comprising of previously existing enterprises. The Examiner refers to step b) as "managing/protecting IP assets....and determining whether the holding company or the operating company should own the IP.. (see Office Action, page 3, line 5). However, this is not what step b) of claim 1 says or implies. Step b) of claim 1 discloses depositing at least one intellectual property asset previously developed for a first application within one of said previously existing enterprises in a common electronic database owned by said holding company... Accordingly, we don't see how Article R1 discloses steps a) and b). Furthermore, the Examiner states that R1 does not teach steps c) and d) of claim 1. Accordingly, we don't see how R1 is even relevant to claim 1, since it does not include all limitations of step a), and does not include steps b), c), and d) of claim 1.

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The Examiner claims that R2 teaches a process/system for assisting a company in protecting IP assets and optimizing uses of IP assets for profitability by using the SmartPatent software to perform steps c) and d) of claim 1. R2 discloses "Smartpatents allows companies to monitor and analyze patents by merging such information with finance, sales, manufacturing, and human resources data. The information can be used to license, trade, or sell patents; to pinpoint new areas for product development; and to analyze the patent activities of competitors." (R2, main paragraph, lines 3-7). We don't see how this statement suggests and/or implies steps c) and d) of claim 1 which state: c) evaluating and developing a second application for said at least same one IP asset, wherein said second application is different from said first application, thereby reusing said at least one IP asset, i.e., reusing previously developed IP assets to develop new applications; and step d) deciding to form said new enterprise based on meeting a set of criteria and wherein said new enterprise is based on said developed second application for said at least one IP asset. There is no reference explicit or implicit to developing a second application based on the same IP asset that was used before for a first application. Claim 1 was amended to emphasize this reuse of IP assets. It is known that one can extract value from existing IP assets through licensing, trade or selling. Reusing existing IP is a novel element of this invention.

Real life examples of this reuse of previously developed IP assets to develop new applications and use these new applications to start new businesses are described in the specification. Referring to page 11 lines 27-31 of the specification, "company A 145 develops air traffic control visualization technology (i.e., a first application)" and "company B 150 develops this intellectual property --- into a virtual online shopping tool (i.e., a second application)". Referring to page 20, lines 4- 9, "Holding company 140 developed simulation learning intellectual property for addressing the needs of a client company in a certain market segment. The initial addressable market segment of the client company was the aerospace industry. Holding company 140 then created a new business, i.e., spinout company A 145, utilizing the simulation learning IP, to provide a simulated job learning environment for any type of corporation". These are two real life examples that are currently being practiced by Adacel Technologies Limited, the assignee

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of this invention, and they exhibit the commercial success of this invention. Furthermore, we would like to point out that there is no motivation to combine R1 and R1 and if it was indeed obvious to combine R1 and R2 in order to arrive to the present invention, why wasn't it done prior to this patent filing, especially, given the current commercial success of the present invention.

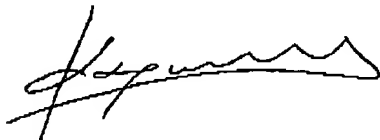
Claim 20 is the corresponding system claim to the method claim 1 and the same arguments apply to it. Accordingly, it is believed that independent claims 1 and 20 define an invention, which is unobvious and patentable over R1 or R2 taken singularly or in combination and as such should be allowed.

Claims 2-19 and 39-40 depend directly or indirectly upon claim 1 and as such should also be allowed. Claims 21-38 and 41-42 depend directly or indirectly upon claim 20 and as such should also be allowed.

Therefore, it is believed that all claims as amended define an invention, which is patentable and unobvious over R1 or R2 taken singularly or in combination. In view of the above, we would like to request reconsideration of the Examiner's rejections.

If this response is found to be incomplete, or if a telephone conference would otherwise be helpful, please call the undersigned at 617-558-5389

Respectfully submitted,



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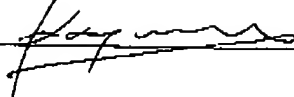
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